
In the United States
Circuit Court of Appeals
For the Ninth Circuit.

Wilson-Western Sporting Goods Co.,
a corporation,

Appellant and Cross-Appellee,

vs.

George E. Barnhart,

Cross-Appellant and Appellee.

CROSS-APPELLANT'S BRIEF.

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No. 7807.

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STATEMENT OF THE CASE.

This is a suit in Equity brought for infringement of Letters Patent No. 1,639,547 and No. 1,639,548, both issued on the 16th day of August, 1927. Both patents concern inventions in golf clubs and particularly with the manner of attaching a tapered hollow steel shaft to the head of the club.

Plaintiff in the suit is George E. Barnhart, of Pasadena, California, who, while not in the business of manufacturing and selling golf clubs, has been engaged for a number of years in the production of improvements relating to tapered drawn steel shafts and the manner of securing such shafts to the heads of golf clubs.

The defendant, Wilson-Western Sporting Goods Co., is a corporation of the state of Maine and is one of the largest manufacturers and distributors of golf clubs and sporting goods in the United States.

The suit was referred to David B. Head, as Special Master, who, in his report [Tr. p. 148] found both of the Letters Patent in suit good and valid in law and claims 11 and 12 of Letters Patent No. 1,639,547 and claim 10 of Letters Patent No. 1,639,548, infringed by defendant by the sale and offering for sale of one type of golf club shown in defendant's 1930 Catalogue and Exhibit 12.

The Master also found that the defendant had not infringed either of the Letters Patents in suit by the selling and offering for sale of another type of golf clubs of the construction shown in Exhibit 3.

Both plaintiff and defendant took exceptions to the Master's report and after oral argument the report was confirmed by the Hon. Paul J. McCormick, District Judge for the Southern District of California, Central Division.

By stipulation the Master's report was adopted as Findings of Fact and Conclusions of Law. [Tr. p. 163.]

Defendant presented a motion for a Bill of Particulars and before filing its Bill of Particulars the defendant, upon written request of plaintiff (Book of Exhibits p. 22), furnished plaintiff with copies of its catalogues entitled "The Gateway to Golf" for the years 1929 to 1933 inclusive.

Upon being furnished with the catalogues, just referred to, plaintiff filed its Bill of Particulars [Tr. p. 13] and among other things charged infringement of the patents in suit by the golf club illustrated on page 4 of the 1930 edition of the "Gateway to Golf," (Book of Exhibits p. 17), the golf club illustrated on page 5 of the 1931 issue of the "Gateway to Golf," (Book of Exhibits p. 19) and also the golf clubs illustrated on certain designated pages of the 1932 and 1933 issue of the "Gateway to Golf."

The clubs found to infringe claims 11 and 12 of the first patent and claim 10 of the second patent are those illustrated in the 1930 issue of the "Gateway to Golf" just referred to. (Exhibit 8-B, Book of Exhibits p. 17 and Exhibit 12.)

Assignments of Error.

The assignments of error relied on by plaintiff in its Cross-Appeal [Tr. p. 180], read as follows:

"(1) In finding and decreeing that claim 10 of United States Letters Patent No. 1,639,548 is not infringed by defendant's golf clubs as shown in Plaintiff's Exhibit No. 3.

(2) In failing to find and decree that defendant's golf clubs as shown in Plaintiff's Exhibit No. 3 infringe claim 10 of Letters Patent No. 1,639,548."

Patents in Suit.

Patent No. 1,639,547, herein referred to as the first patent in suit, points out that at the time of the application, to-wit, October 14, 1926, the golf clubs then in use were provided with either wooden shafts or those made of

steel tubing, that although the golf clubs with wooden shafts provided flexibility and resiliency both longitudinally and torsionally, the shafts of such clubs break frequently at the portions where the shaft enters the head and that although the steel shafts were more durable such shafts also break frequently at the portions secured to the heads.

In the form of the invention illustrated in this patent [Tr. p. 2] it is to be noted that the bore of the upper end of the hosel or socket (referred to in the patent as a ferrule) is flared outwardly so that the extreme upper end of the hosel does not fit tightly about the shaft and it is this particular feature which permits the shaft at the outer end of the hosel or socket to move within the end of the hosel. It is also this feature which permits a gradual bending of the shaft within the end of the hosel, as distinguished from the common form in which the shaft bends over a sharp end of the hosel, and to which claims 11 and 12 of this patent are directed. These claims read as follows:

“11. In a golf club, a head member provided with a socket and with a shaft, the latter being secured at its one end within the inner portion of the socket, the portion of the shaft near the outer end of said socket being freely movable within and relative to and about the outer end portion of said socket to prevent buckling of said shaft at the outer end of the socket.

12. In a golf club, a head member provided with a socket and with a shaft, the latter being secured at its one end within the inner portion of the socket, the bore at the outer end of said socket being outwardly divergent forming a fulcrum about which said shaft is flexed longitudinally when striking a ball with the golf club.”

In the second patent in suit, to-wit, No. 1,639,548, claim 10 held to be infringed by the club illustrated in the 1930 edition of the "Gateway to Golf" is drawn to the same general features as claims 11 and 12 in the first patent but with the additional feature of the inclusion of a bushing placed within the outer end of the hosel and between the hosel and the shaft.

Claim 10 of the second patent reads as follows:

"10. In a golf club, a head having a socket, a shaft secured at one end within said socket, the portion of the shaft within the outer end of the socket being movable relative to the latter, and a flexible sealing member positioned at the joint between the outer end portion of said socket and said shaft."

On page 2 of the second patent (Book of Exhibits, p. 10, line 101), a flexible cap such as shown in Fig. 6 of the drawings (Book of Exhibits p. 8) is described as for the purpose of—

"excluding dirt, dust and grit from entering the ferrule and lodging between the same and the shaft and thus preventing proper co-action between the same."

also—

"Thus, the shaft is permitted to flex, twist and expand relative to the ferrule and still exclude dirt, dust and grit therefrom. It will be noted that a similar sleeve may be positioned around the joints of the ferrules and shafts shown in Figures 3, 4 and 5, *or a cap, or washer may be positioned within the end of the ferrule around the shaft.*" (Italics ours.)

It is this particular construction of a hosel having a flared or wide mouth which permits the shaft to bend within the end of the hosel against a resilient member or cushion to which claim 10 of the second patent is directed.

Validity.

The Master, in his Findings [Tr. p. 154), stated that—
“the claims of the first patent in issue are limited to the flared end portion of the socket which functions to lessen the strain on the shaft at the point of juncture with the hosel.”

and that—

“The claim of the second patent in issue is directed to the combination of a flexible bushing and the flared socket without regard to the slotted shaft.”

He also stated:

“At first glance it would appear that the flaring of the outer portion of the socket would be an obvious way in which to distribute the strain at the point of juncture of the shaft and hosel. However, an examination of the prior art patents does not disclose any suggestion of such a construction. This tends to strengthen the presumption of invention.”

The Master then concluded that claims 11 and 12 of the first patent, together with claims 13 and 15 of that patent were valid. With respect to claim 10 of the second patent the Master stated as follows [Tr. p. 155]:

“Claim 10 of the second patent was allowed without comment by the Patent Office: Other claims drawn to the construction of Figure 6 were rejected. The patent to Lard, Exhibit J-3, was not cited. The function of the washers in Lard and the bushing of the patent is the same, *i. e.*, to exclude dirt from the socket. However, the relative movement between the shaft and socket in the structure of the patent is not found in the Lard club. The patentee’s problem was to provide a sealing means which was sufficiently

flexible to permit this movement. The presumption of validity has not been rebutted and it is concluded that the claim is valid. It appears that the claim should be limited to the use of a sealing member in a structure where the shaft and socket are relatively movable in the manner disclosed by the patent.”

It is this claim 10 of the second patent that is involved in this Cross-Appeal, insofar as the Master found this claim not infringed by the particular golf club marketed by defendant, shown by Exhibit 3.

ARGUMENT.

POINT I.

It Is Plaintiff's Contention That the Golf Club Exemplified by Plaintiff's Exhibit No. 3, Is an Infringement of Claim 10 of the Barnhart Patent No. 1,639,548.

The particular question before this Court on the Cross-Appeal can best be illustrated by comparing the construction of the club found not to infringe claim 10 of the second patent with the structure illustrated in Exhibit 8-B (Book of Exhibits p. 17) found to infringe that claim.

The illustration on this page shows the upper portion of the hosel cut away thereby illustrating the internal structure of the hosel at that point. It will be noted that the steel shaft extends into the hosel and that the lower end engages the inner walls of the hosel at that portion marked "close frictional fit" from that point upwardly the inner walls of the hosel flare outwardly forming a space between the shaft and the flared walls

of the hosel, marked on the illustration "chamber." Seated on the upper end of the hosel and extending downwardly into the chamber is a bushing formed of specially treated rubber, marked on the illustration "rubber bushing." The shaft is further secured in the hosel by means of a rivet marked on the illustration "anchoring."

The only difference between this structure which the lower court held to infringe claims 11 and 12 of the first patent and claim 10 of the second patent is in the shape of the inner wall of the hosel at the part marked "chamber" in the illustration. In the club held not to infringe (Plaintiff's Exhibit 3) the inner wall of the hosel is not flared outwardly as shown in the illustration in the Book of Exhibits p. 17, but the "close frictional fit" extends upwardly to the lower end of the rubber bushing, at which point a shoulder is formed leaving a space between the hosel and shaft in which the rubber bushing is seated.

The record shows that there was evidence, pro and con, about the advantages of the patented construction but while the defendants lavishly praised the prior art patents the reading matter opposite the illustrations on page 17 of the Book of Exhibits is a record made by the defendant of what it thought of the invention as long ago as the year 1930. This printed statement by defendant reads as follows:

"Outstanding among Wilson features for golf club improvement is the new 'no shock' development. This feature forstalls any possibility of shock, at the

time of impact, being transmitted from the club head through the shaft. This invention is so ingeniously worked out that it is possible to obtain this freedom from shock and still have the shaft actually anchored to the club head. This makes it absolutely impossible for the club head to turn upon the shaft. The illustration clearly gives you the story of this scientific improvement. Note that the lower end of the shaft is secured to the hosel not only by a frictional contact but also by a metal rivet running clear through the shaft and hosel, which prevents all possibility of turning. Then note that the hosel spreads out in a manner similar to the type of hosel used for wooden shafts and that into the space thus created between the shaft and upper hosel is inserted a bushing of specially treated rubber. This rubber bushing acts as a shock insulator and also allows a slight independence of movement between the hosel and shaft which results in the much desired effect of torsion found in the finest wooden shafts.

These improvements are unique and will be found in clubs built by no other manufacturer. Experts have acclaimed them as being the most valued improvement ever brought to steel shafted irons."

At the trial of this case defendant offered evidence to show that its structure did not include "a shaft secured at one end within said socket," that by reason of the fact that the rivet passing through the hosel or socket in the shaft therein part way up the socket that shaft was not secured at one end. In this connection the reading matter in the catalogue above referred to was contrary

to defendant's contention at the trial as it plainly states that—

“the *lower end* of the shaft is secured to the hosel not only by a frictional contact but also by a metal rivet running clear through the shaft and hosel, which prevents all possibility of turning.” (Italics ours.)

It may be true that Fig. 5 of the second patent in suit (Book of Exhibits p. 8) shows a rivet closer to the lower end of the shaft than defendant places its rivet, but in both instances the *lower end* of the shaft is secured by such means in the hosel.

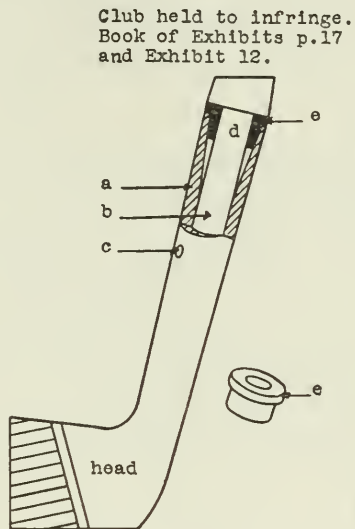
It is plaintiff's contention that whether the inner wall of the hosel is flared outwardly at the top, which form was held to infringe claim 10, or whether the hosel has a shoulder formed therein near the top as in Exhibit 3, that in both forms the shaft within the outer end of the socket is movable relative to the socket, that the rubber cushion or bushing prevents the shaft from bending too abruptly over the shoulder whereby the common breaking of the shaft is minimized, and that both forms infringe claim 10 of the second patent in suit.

On the following page herein is illustrated the construction of the club shown on page 17 of the Book of Exhibits held to infringe claim 10 of the second patent in suit, and the construction of the club typified by Exhibit 3 held not to infringe that claim. Plaintiff submits that these illustrations demonstrate that both constructions infringe claim 10 of the second patent in suit.

CLAIM 10.

In a golf club,

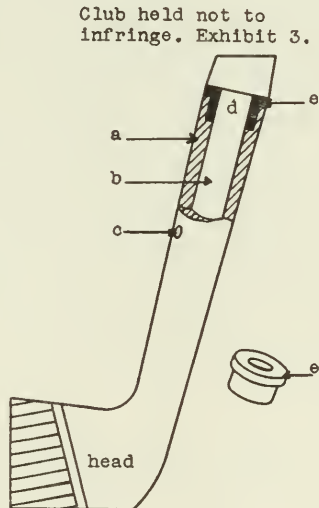
- (a) a head having a socket,
- (b) a shaft
- (c) secured at one end within said socket,
- (d) the portion of the shaft within the outer end of the socket being movable relative to the latter, and
- (e) a flexible sealing member positioned at the joint between the outer end portion of said socket and said shaft.



CLAIM 10.

In a golf club,

- (a) a head having a socket,
- (b) a shaft
- (c) secured at one end within said socket,
- (d) the portion of the shaft within the outer end of the socket being movable relative to the latter, and
- (e) a flexible sealing member positioned at the joint between the outer end portion of said socket and said shaft.



In both forms shown on the preceding page the end of the socket is cut away on the inside to permit "the portion of the shaft within the outer end of the socket" to be "movable relative to the latter."

Each construction includes the "flexible sealing member positioned in the joint between the outer end portion of said socket and said shaft" as called for in the claim.

The Master in his report [Tr. p. 155] stated:

"It appears that the claim should be limited to the use of a sealing member in a structure where the shaft and socket are relatively moveable in the manner disclosed by the patent."

It is true that the patent shows the inner bore of the hosel or socket as flared outwardly, but it is plaintiff's contention that whether the inner bore is flared outwardly identically as shown in the patent or whether it is formed with a step as shown in Exhibit 3, both the flared inner bore and the stepped inner bore provide a space between the hosel and the shaft which permits "the shaft within the outer end of the socket being moveable relative to the latter" as called for in claim 10, and that the flexible bushing interposed in the end of the hosel between the hosel and the shaft performs the same function in both cases.

It needs no citation of authority to show that Exhibit 3 is an infringement of the claim and this court is well aware of the rule that the simplicity or obviousness of a thing does not negative invention.

Claim 10 reads directly on Exhibit 3 and it is plaintiff's contention that the structure of the club, Exhibit 3, is clearly an equivalent of the structure of the patent and of the structure of the club held to infringe. Mr. Justice Clifford in *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. 120, 125, 24 L. Ed. 935, stated as follows:

“Except where form is of the essence of the invention, it has but little weight in the decision of such an issue, the correct rule being that, in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result; always bearing in mind that devices in a patented machine are different in the sense of the patent law when they perform different functions or in a different way, or produce a substantially different result.”

The question of novelty and utility may well be disposed of in the words of the Special Master [Tr. p. 155]:

“The defendant's adoption of the features of the patents here in issue is a use which tends to strengthen the presumptions of novelty and utility. *Hallock v. Davison*, 107 F. 482; *Kelsey Heating Co. v. James Spear etc. Co.*, 155 F. 976.”

Conclusion.

It is finally submitted that the golf club, Exhibit 3, is an infringement of claim 10 of Letters Patent No. 1,639,548 and that the interlocutory decree heretofore entered herein should be modified to so decree.

Respectfully submitted,

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